

REMARKS

Claims 53, 63, and 64 are pending. No claims are added, amended, or canceled. Based on recent amendments to the claims, Applicants submit herewith papers implementing a change of inventorship.

Applicants would like to thank the Examiner for the interview on March 3, 2005. During that interview, Applicants' attorney, Joseph Lucci, noted that the outstanding rejections for alleged obviousness-type double patenting do not satisfy the requirements of MPEP § 2144.08. As was discussed during the interview, the mere fact that a claim under examination overlaps with a claim of an issued patent is not sufficient to support an obviousness-type double patenting rejection. For example, although claims 53, 63, and 64 stand rejected for alleged obviousness-type double patenting over claim 1 of the U.S. Patent No. 5,773,571 ("the 571 patent"), the Examiner has not demonstrated that those of ordinary skill having knowledge of the claim 1 would have found the instant claims to have been obvious.

Although the Advisory Action asserts that there is overlap among the claims, no such overlap actually exists. In the instant claims, for example, each pair of A-A<sub>m</sub> and B-B<sub>m</sub> are >N-C(O)CH<sub>2</sub>-. Such a structure is possible in the context of claim 1 of the 571 patent, only if variable J is selected to be N. This selection, however, imposes two requirements that exclude the compounds of the instant claims. The first requirement is that at least one of y or z is other than 1 or 2, whereas y would have to be 1 and z would have to be 2 to embrace the instant claims. The second requirement is that at least one linking group is of formula >N-[CR<sup>1</sup>R<sup>2</sup>]<sub>s</sub>-Y-[CR<sup>1</sup>R<sup>2</sup>]<sub>s</sub>-NR<sup>3</sup>-C(=X)-, which does not include >N-C(O)CH<sub>2</sub>- in its scope. (See claim 1 at column 91, line 45 to column 92, line 5).

Even if there were overlap, the MPEP cautions that this still would provide inadequate support for an obviousness-type double patenting rejection. MPEP § 2144.08, for example, states that "[t]he fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness." MPEP § 2144.08, II.<sup>1</sup> Rather, there must be a teaching that would have motivated one of ordinary skill in the

<sup>1</sup> As will be recognized, the analytic approach employed in connection with an obviousness-type double patenting determination parallels that employed in connection with a 35 U.S.C. § 103 obviousness determination. *In re Braat*, 19 U.S.P.Q.2d 1289 (Fed. Cir. 1991).

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